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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,986	12/17/2003	Matthew Terwillegar	102456-40307225	6446
43569	7590	10/06/2006		
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1714	PAPER NUMBER
DATE MAILED: 10/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/736,986	TERWILLEGAR, MATTHEW	
	Examiner	Art Unit	
	Patrick D. Niland	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4390662 Ando et al..

Ando discloses the inventions of the instant claims at the abstract; column 2, lines 5-68, particularly the formula and lines 50-64; column 3, lines 1-68, particularly 24-26, 27-34, which clearly specifies the use of the instantly claimed “polyalkyesters” and transesterification catalysts, and 34-44 which OH number encompasses the instantly claimed polyester molecular weights of claims 1 and 15 by definition thereof and line 44 falls within the scope of the instantly claimed polyalkylesters of claims 1, 2, 3, 6, 7, 13, and 28. Based on the relationship of viscosity to molecular weight based on the definition of viscosity average molecular weight and the fact that the polyester polyols of the patentee have the instantly claimed molecular weights and are made from the instantly claimed monomers, they must necessarily inherently possess the viscosities of the instant claims 16-17. The acid number of column 3, lines 38-40 falls within the scope of the instant claim 18. The urethane groups of the patentee’s formula are the “polymeric unit” of the instant claim 14. Column 3, lines 50-52 falls within the scope of the instant claims

8-9. See column 4, lines 1-68; and the remainder of the document. The styrene of the styrene solutions of column 7, lines 18, 22, and 33 is a reactive diluent of the instant claim 20. Since the polyesterurethane acrylates of the patentee fall within the scope of those of the instant claims, are described as tough and having improved physical properties (column 5, lines 25-55), being rubbery (column 5, lines 64-67), and having improved impact strength and improved elongation (column 6, lines 22-30), it is expected to necessarily inherently possess the properties of the instant claims 21-24. It is not seen that the difference in the indices of refraction of the coatings of Ando and the glass fibers of column 14, lines 46-59 did not inherently result in “optical fibers” of the instant claims 26-27.

4. Claims 1-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4390662 Ando et al..

Ando discloses the inventions of the instant claims at the abstract; column 2, lines 5-68, particularly the formula and lines 50-64; column 3, lines 1-68, particularly 24-26, 27-34, which clearly specifies the use of the instantly claimed “polyalkyesters” and transesterification catalysts, and 34-44 which OH number encompasses the instantly claimed polyester molecular weights of claims 1 and 15 by definition thereof and line 44 falls within the scope of the instantly claimed polyalkylesters of claims 1, 2, 3, 6, 7, 13, and 28. Based on the relationship of viscosity to molecular weight based on the definition of viscosity average molecular weight and the fact that the polyester polyols of the patentee have the instantly claimed molecular weights and are made from the instantly claimed monomers, they must necessarily inherently possess the viscosities of the instant claims 16-17. The acid number of column 3, lines 38-40 falls within the scope of the instant claim 18. The urethane groups of the patentee’s formula are the “polymeric

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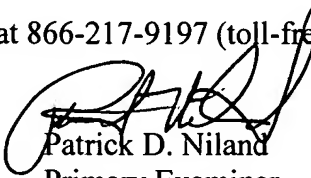
unit” of the instant claim 14. Column 3, lines 50-52 falls within the scope of the instant claims 8-9. See column 4, lines 1-68; and the remainder of the document. The styrene of the styrene solutions of column 7, lines 18, 22, and 33 is a reactive diluent of the instant claim 20. Since the polyesterurethane acrylates of the patentee fall within the scope of those of the instant claims, are described as tough and having improved physical properties (column 5, lines 25-55), being rubbery (column 5, lines 64-67), and having improved impact strength and improved elongation (column 6, lines 22-30), it is expected to necessarily inherently possess the properties of the instant claims 21-24. It is not seen that the difference in the indices of refraction of the coatings of Ando and the glass fibers of column 14, lines 46-59 did not inherently result in “optical fibers” of the instant claims 26-27.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed components and methods to make the instantly claimed oligomers and compositions because they are encompassed by Ando and would have been expected to give the improved properties of Ando discussed above, such as improved physical properties, improved rubberiness, improved elongation, etc.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714